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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/735,426

12/12/2003

Marion Heinz

12251

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28484 7590 02/22/2007

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GERMANY

EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1711

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|-----------|---------------|
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3 MONTHS

02/22/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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|                              |                               |                              |  |
|------------------------------|-------------------------------|------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/735,426 | Applicant(s)<br>HEINZ ET AL. |  |
|                              | Examiner<br>Rabon Sergeant    | Art Unit<br>1711             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have failed to define the term, "essentially compact", as it pertains to the invention, as claimed. Applicants have stated within their response of March 6, 2006 that the term requires that the adduct be non-foamed, which is considered to mean that the adduct is devoid of cells or a cellular structure. However, the claims clearly provide for the presence of hollow microspheres, which will yield an adduct having cells or a cellular structure. In response, applicants have argued that the term pertains to foaming that occurs as a result of the reaction between the isocyanate and co-reactants and does not pertain to the introduction of cells by such means as adding hollow fillers. The examiner has considered this argument; however, in the absence of a definitive definition within the specification or other evidence, there is nothing on the record to support applicants' position that the term should be so narrowly defined. In other words, it has not been established that one of ordinary skill in the art would interpret "essentially compact" as only excluding cells produced as a result of a conventional isocyanate foam yielding reaction.

2. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Firstly, for the reasons given within paragraph 1, the requirement that the adduct be essentially compact cannot be reconciled with the requirement that hollow microspheres be present, as this will yield an adduct having cells or a cellular structure.

Secondly, within claims 8 and 11-13, the components for b) are not mutually exclusive. Despite applicants' response, the position is maintained that Component bi) overlaps Component bii), and Component bv) overlaps Components biii) and biv), in terms of functionality and molecular weight. As drafted, a single specific reactant will satisfy the requirements of multiple components; accordingly, one of ordinary skill could not clearly determine the metes and bounds of the claim, since one could not determine if multiple components, though overlapping, are required. Applicants' response has been carefully considered; however, the examiner cannot agree with applicants' remarks that to the extent there is any overlap, additional elements would just be required. The position is maintained that one of ordinary skill in the art faced with a process comprising applicants' components a) and c) and applicants' index value and a b) component comprising, for example, a polyether triol having a molecular weight of 2,000 g/mol could not readily distinguish such a process from the claimed process, since applicants' bi) and bii) components are satisfied. The position is ultimately taken that to define the components as claimed introduces a degree of ambiguity into the claims that renders the claims indefinite.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 8-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bartz et al. (US 2001/0051261).

Bartz et al. disclose compact polyurethanes produced from polyisocyanates which may be higher than difunctional (note the use of p-MDI and mixtures thereof within paragraph [0025]) and polyol components that meet those claimed. Applicants' components bi), bii), and biii) are met by the reference's component b13). Applicants' component biv) are met by the reference's component b11). Applicants' component bv) is met by the reference's component b12). See paragraphs [0001] through [0029], [0031], and [0034].

5. Applicants have argued that the reference fails to disclose applicants' polyol components with sufficient specificity to anticipate the claims. In response, given that the reference encompasses mixture of polyols, that applicants' various polyols overlap and may be met by a single polyol (as set forth within paragraph 2), and that applicants' claims set forth no quantitative amounts of the polyols, the position is taken that the teachings of the reference is adequate to anticipate the claims.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent  
February 17, 2007

  
**RABON SERGENT**  
**PRIMARY EXAMINER**